

**IN THE DRAWINGS:**

Please replace the drawings with the formal drawings attached as Appendix A.

**REMARKS**

The Office Action dated December 15, 2004, has been received and carefully considered. In this response, claim 1 has been amended, and claims 42-63 have been cancelled without prejudice. Entry of the amendments to claim 1 is respectfully requested. Reconsideration of the outstanding objections/rejections in the present application is also respectfully requested based on the following remarks.

I. **THE OBJECTION TO THE DRAWINGS**

On page 2 of the Office Action, the drawings were objected to as containing informalities. In response, Applicants request that the drawings of record be replaced with the formal drawings that are attached hereto as Appendix A.

In view of the foregoing, it is respectfully requested that the aforementioned objection to the drawings be withdrawn.

II. **THE PATENTABILITY REJECTION OF CLAIMS 1-41**

On page 2 of the Office Action, claims 1-41 were rejected under 35 U.S.C. §101 because the claimed invention is alleged to be directed to non-statutory subject matter. In particular, the Examiner states that “[t]he claimed subject matter is not adequately tied to a technological art or environment and reads on an abstract idea.” The Examiner requested that the claims be amended to include a computer.” In response, Applicants have amended independent claim 1 to clarify that the process is performed by a computer. Claims 2-41 depend from claim 1 and thus are also performed by a computer.

In view of the foregoing, it is respectfully requested that the aforementioned patentability rejection of claims 1-41 be withdrawn.

III. THE OBVIOUSNESS REJECTION OF CLAIMS 1-41

On page 3 of the Office Action, claims 1-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Payments International, n 113, p 8+ (“EPI”) in view of Official Notice. This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner asserts that EPI teaches “a paperless, computer implemented, automatically generating method of processing trade documents..., [k]nown as the Bolero...that is said to include an electronic registry for trade documents. (Text, Paragraph 3).” The Examiner also asserts that “[w]hile the [EPI] does not detail each of the method steps of the claims, it does state that a request for a proposal to build the system was issued. (Text, Paragraph 7.)” The Examiner submits that “[i]t would have been obvious for one skilled in the art at the time to have included any step previously performed manually in the processing of trade documents into the Bolero project as motivated by the need to make the system fully automated and functional.” The Examiner also states that “[o]fficial notice is taken that the method steps of claims 1-41 have a trivial manual counterparts.”

Applicants respectfully traverse this rejection. In particular, Applicants respectfully submit that the Office Action does not refer to particular claim limitations in the § 103 analysis, nor otherwise follow the 3-prong inquiry under *Graham v. John Deere* required by MPEP § 2142. For at least this reason, the § 103 rejection should be withdrawn.

Moreover, the Office Action does not set forth a proper motivation to modify EPI to include each of the steps recited in claims 1-41. After conceding that EPI does not disclose the steps of claims 1-41, the Office Action states that EPI's disclosure of a "request for proposal" would lead one skilled in the art to include any step previously performed manually in the processing of trade documents into the Bolero project. The Office Action submits the requisite motivation would come from the need to make the system "fully automated and functional."

Applicants respectfully disagree. Under the Office Action's "request for proposal" rationale, any step remotely associated with trade document processing would be deemed obvious over the EPI reference. Furthermore, only upon viewing the pending claim limitations is the alleged motivation fully substantiated. Clearly, this is not proper procedure -- an Office Action cannot rely on the language of the claims to provide the motivation required for *prima facie* obviousness. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.) However, even indulging the "request for proposal" rationale, Applicants submit that one of ordinary skill in the art would create a system or method that complies with the specific requirements set forth in the EPI reference, namely, an electronic registry for trade documents that can be accessed by participants to a trade transaction. Because the EPI reference does not -- as the Office Action concedes -- teach or suggest the steps of claims 1-41, one responding to the request for proposal would not

be inclined to include them. Thus, the Office Action's "request for proposal" rationale is nothing more than an improper "catch-all" argument that deems unpatentable any automated system or method for processing trade documents that is alleged to incorporate a known manual counterpart.<sup>1</sup>

Accordingly, Applicants respectfully request that the next Office Action present appropriate reference(s) that disclose each and every claim limitation. To the extent the Office Action takes Official Notice of the claimed method steps, Applicants respectfully submit that there is no support in the record for the conclusion that each of the identified features of the pending claims are "old and well known." Therefore, in accordance with MPEP § 2144.03 Applicants respectfully request that the Examiner cite a reference(s) in support of his position that the method steps of claims 1-41 have "trivial manual counterparts."

Although Applicants do not agree with the pending rejections, Applicants have nonetheless amended the claims to better recite the claimed systems and methods and distinguish the cited reference. In particular, independent claim 1 has been amended to further recite the step of "verifying the accuracy of the trade documents." Applicants respectfully submit that the EPI reference does not teach or suggest any such feature or functionality. Accordingly, Applicants respectfully submit that independent claim 1, as amended, is allowable over the cited references.

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<sup>1</sup> Applicants respectfully remind the Examiner of compelling authority prohibiting "per se" rules of obviousness. *See, e.g., In re Orchiai*, 71 F.3d 1565, 1572, 37 U.S.P.Q.2d 1127, 1133 (Fed. Cir. 1995) ("reliance on per se rules of obviousness is legally incorrect"); *Ex parte Brouillet*, 2001 WL 1339914, \*2 (Bd. Pat. App. & Interf. 2001) ("In the present case, unlike in *Venner*, the examiner has not provided a reference which discloses a high speed rotary power tool, let alone one which is used for cleaning glass. The examiner has merely relied upon a per se rule that providing a mechanical or automatic means to replace manual activity which has accomplished the same result is unpatentable.")

Claims 2-41 are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 2-41 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, claim 20 -- which depends from claim 1 via claim 17 -- recites the additional steps of comparing the sales order to the requirement information contained in the database in order to determine any discrepancies, and correcting the sales order if there are any discrepancies, thereby generating a matched sales order.” Applicant respectfully submits that the EPI reference does not teach or suggest any such feature or functionality.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-41 be withdrawn.

#### IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

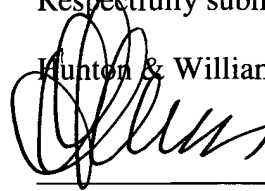
To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper,  
including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess  
fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

By:



Ozzie A. Farres  
Registration No. 43,606

Hunton & Williams LLP  
1900 K Street, N.W.  
Washington, D.C. 20006-1109  
Telephone: (202) 955-1500  
Facsimile: (202) 778-2201

Date: March 14, 2005

**APPENDIX A**